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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* MICHAEL C. SCOGGIE,
9 MICHAEL E. KACABA,
10 DAVID A. ROCHON, and
11 DAVID M. DIAMOND
12

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14 Appeal 2008-004478
15 Application 09/401,939
16 Technology Center 3600
17

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19 Decided: July 15, 2010
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22 Before HUBERT C. LORIN, ANTON W. FETTING, and
23 BIBHU R. MOHANTY, *Administrative Patent Judges*.
24 FETTING, *Administrative Patent Judge*.

25 DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

This is a decision on rehearing in Appeal No. 2008 - 004478. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Requests for Rehearing are limited to matters misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52 (2005).

ISSUES ON REHEARING

Appellants raise five issues in the Request for Rehearing. The Appellants argue an incorrect standard of review; an incorrect conclusion as to the law of claim construction; improper reliance upon an alleged dictionary definition; adjudication not in compliance with precedential legal requirements by failing to address in the decision points raised in the brief regarding the specification's definition of a "personal computer"; and an incorrect conclusion of law that the claimed "personal computer" reads on Nichtberger's CDR unit 20.

ANALYSIS

We found in our decision that claims 32-40, 43, 45-53, 56, 58-66, 69, and 71-76 were anticipated by Nichtberger or unpatentable over Nichtberger and Barnett. Decision 12.

Standard of Review

The Appellants first argue the Board improperly placed the burden of showing the Examiner erred rather than showing the rejection was in error on the Appellants. Request 3.

The Board reviews the particular finding(s) contested by an Appellant anew in light of all the evidence and argument on that issue.

Filing a Board appeal does not, unto itself, entitle an Appellant to *de novo* review of all aspects of a rejection. If an Appellant fails to present arguments on a particular issue - or, more broadly, on a

1 particular rejection - the Board will not, as a general matter,
2 unilaterally review those uncontested aspects of the rejection.

3 *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010).

4 In the Decision, the panel reviewed the particular findings contested by the
5 Appellants anew in light of all the evidence and argument on that issue. Decision
6 Analysis at 8-12. As a result the panel found the rejections, except for that
7 regarding anticipation of claims 41, 42, 44, 54, 55, 57, 67, 68, and 70, were not in
8 error.

9 *Construction of “personal computer”-Proper definition*

10 The Appellants next argue that the construction of the phrase “personal
11 computer” ignored the Specification. The fourth and fifth arguments similarly
12 contend the panel did not consider the arguments in the Appeal Brief as to the
13 definition of the phrase, and improperly relied on the panel’s construction.

14 During examination of a patent application, pending claims are given their
15 broadest reasonable construction consistent with the specification. *In re Prater*,
16 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d
17 1359, 1369 (Fed. Cir. 2004).

18 Limitations appearing in the specification but not recited in the claim are not
19 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
20 Cir. 2003) (claims must be interpreted “in view of the specification” without
21 importing limitations from the specification into the claims unnecessarily)

22 Although a patent applicant is entitled to be his or her own lexicographer of
23 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
24 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
25 definitions in the specification with sufficient clarity to provide a person of

ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

The panel found that the Specification contained no lexicographical definition of the phrase “personal computer.” Decision 4: Finding of Fact 1. The panel also found that the ordinary and customary meaning of “personal computer” is a computer built around a microprocessor for use by an individual. The Appellants contend the panel’s finding was that there was no dictionary definition in the Specification. Request 4. This is not quite correct. The panel found there was no lexicographic definition, *i.e.* an unambiguous definition by the Appellants acting as their own lexicographer that controlled the construction of the phrase as used in the claims.

The Appellants point out their section entitled “Definition of personal computer” in the Appeal Brief at 16-18. Nowhere in that portion of the Appeal Brief is there cited a section of the Specification that actually defines the phrase “personal computer.” The Appellants do not contend otherwise. The Appellants’ contention is that the construction used by the panel was inconsistent with how that term was used in the Specification. But the only two instances in which the phrase occurs (Specification 1:18 and 18:23) would fit within the scope of that construction. So the Appellants contend the panel’s construction is unduly broad. Request 9-12. But the adjective “personal” is itself very broad and is hardly structural in meaning. The scope of the word “personal” encompasses use by a

1 person, or being of a character such as those used by individual persons, which is
2 how the panel construed the term. The Appellants cite no portion of the
3 Specification that specifically states how the adjective “personal” structurally
4 modifies the noun “computer” but instead makes general inferences regarding the
5 capacity of such a computer, although nothing in the claims or Specification
6 requires such capacity.

7 *Construction of “personal computer” – Dictionary definition*

8 The Appellants also argue that the dictionary definition includes a further
9 limitation that a personal computer is in an office or at home or school. Request 6.
10 While it is true that the definition in the cited American Heritage Dictionary of the
11 English Language has attached to it the phrase “as in an office or at home” this is
12 not part of the definition, but merely lists exemplary contexts in which personal
13 computers are found.² The Appellants contend that a maxim applied to statutory
14 construction (“*inclusio unius est exclusio alterius*” - Request 6) implies that a
15 definition should be limited by the examples provided, but examples provided with
16 dictionary definitions are merely provide helpful suggestions, and are not
17 themselves limiting. Further, claim construction differs from statutory
18 construction, and the principal of construing claims as broadly as possible within
19 the context of the Specification would make such an argument unpersuasive. The
20 Appellants next contend that these dictionary examples connote a degree of
21 portability, but again, these are exemplary contexts only, they do not refer to
22 portability, and nothing in the definition itself explicitly refers to anything portable.

² As the Appellants request, we attach a copy of the dictionary page cited in the Decision showing the definition.

Finally, the Appellants at Request 7 refer to Nichtberger's computer being five feet tall, but the Appellants refer to the kiosk housing, not the computer inside. The microprocessor and related circuitry would be much smaller, that is the personal computer used by Nichtberger is a computer built around a microprocessor for use by an individual housed within the kiosk rather than being the kiosk itself.

CONCLUSION

Nothing in Appellants' request has convinced us that we have overlooked or misapprehended the proper construction of "personal computer" as argued by Appellants. Accordingly, we deny the request as to reversing the Examiner.

DECISION

To summarize, our decision is as follows:

- We have considered the REQUEST FOR REHEARING
- We DENY the request that we reverse the Examiner as to claims 32-40, 43, 45-53, 56, 58-66, 69, and 71-76.

REHEARING DENIED

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